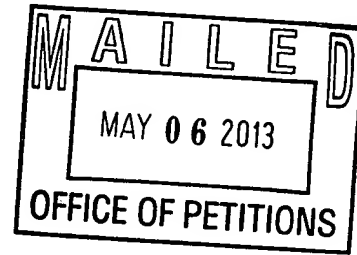




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DENTONS US LLP  
P.O. BOX 061080  
CHICAGO IL 60606-1080



In re Patent No. 6,716,619 :  
Issue Date: April 6, 2004 :  
Application No. 09/779,187 :  
Filed: February 8, 2001 :  
Attorney Dkt. No. : 5568/1070 :  
For: STYLET FOR USE WITH TISSUE :  
MICROARRAYER AND MOLDS :

ON PETITION

This is a decision on the petition under 37 CFR 1.378(b), filed March 30, 2013, to accept the unavoidably delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of \$400 as set forth in 37 CFR 1.17(f). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, the Director will undertake no further reconsideration or review of the matter. This includes statements by all persons with direct knowledge of the cause of the delay, setting forth the facts, as they know them. If a request for reconsideration is filed, it must establish that the entire delay in the submission of the maintenance fee was unavoidable.

The patent issued April 6, 2004. The 3.5 year maintenance fee could have been paid from April 6, 2007 to October 5, 2007, or with a surcharge during the period from October 6, 2007 to April 6, 2008. Petitioner did not do so. Accordingly, the patent expired April 7, 2008.

A petition to accept the delayed payment of a maintenance fee under 35 USC 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate showing that the delay was unavoidable, since reasonable care was taken to insure that the maintenance fee would be paid timely, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1). This petition lacks item (1) above.

A petition under 37 CFR 1.378(b) for the acceptance of an unavoidably delayed payment of maintenance fee is considered under the same standard as that for reviving an application unavoidably abandoned under 37 CFR 1.137(a) because 35 U.S.C. § 41(c)(1) uses the identical language, *i.e.*, "unavoidable" delay.<sup>1</sup> Decisions reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.<sup>2</sup> In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account."<sup>3</sup> Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.<sup>4</sup>

The general standard applied by the Office requires petitioner to establish that petitioner treated the patent the same as a reasonable and prudent person would treat his or her most important business.<sup>5</sup> However, "the question of whether an applicant's delay in prosecuting an application was unavoidable [will] be decided on a case by case basis, taking all of the facts and circumstances into account".<sup>6</sup> Nonawareness of the content of, or misunderstanding of PTO statutes, PTO rules, the MPEP or Official Gazette notices, do not constitute unavoidable delay.<sup>7</sup> The statute requires a "showing" by petitioner. Therefore, petitioner has the burden of proof.

The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business.<sup>8</sup>

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<sup>1</sup> Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995)(quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988)).

<sup>2</sup> Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful man in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

<sup>3</sup> Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute unavoidable delay); Vincent v. Mossinghoff, 1985 U.S. Dist. Lexis 23119, 13 230 U.S.P.Q. (BNA) 621 (D.D.C. 1985) (Plaintiffs through their counsel's actions or their own must be held responsible for having noted the MPEP section and Official Gazette notices expressly stating that the certified mailing procedures outlined in 37 CFR 1.8(a) do not apply to continuation applications).

<sup>4</sup> Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

<sup>5</sup> The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard 35 U.S.C. 41(c)(1) states, "The Commissioner may accept the payment of any maintenance fee...at any time...if the delay is shown to the satisfaction of the Commissioner to have been unavoidable (emphasis added).

<sup>6</sup> Smith v. Mossinghoff, 671 F.2d at 533.

<sup>7</sup> *Id.* at 538.

<sup>8</sup> In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); *see also* Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), *aff'd*, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

**PETITIONER'S ARGUMENT**

- The instant petition was filed on behalf of assignee Nuclea Biotechnologies, Inc. ("Nuclea").
- At the time the 3.5 year maintenance fee was due the instant patent was owned by Laurus Master Fund, LTD ("Laurus").
- According to Cameron Rasmussen, Agent of the Joint Official Liquidators for Laurus, the SNR Denton US LLP ("SNR") firm was responsible for paying the maintenance fees for the instant patent. Rasmussen states that the failure to pay the maintenance fee was unavoidable due in part to the unfortunate circumstance surrounding the liquidation of the Laurus business entity. Laurus entered liquidation in September 2008.
- Mr. Rasmussen states that it was his understanding that the SNR law firm was instructed to and was responsible for paying the maintenance fees for the patent. Mr. Rasmussen acknowledges if a request for fee payment instructions was received from Laurus, it is possible that the request from SNR may have been overlooked. Mr. Rasmussen states he is not aware of such a request and it is his understanding that the property of Laurus would have been maintained even in the absence of such a request.
- Attorney Paula Evans, formerly of SNR, current Executive Vice President and General Counsel of Nuclea states that SNR did docket and track maintenance fees and notify clients as necessary in order to manage their intellectual property. Attorney Evans states that it is her belief that this docketing system was utilized to manage the instant patent until her departure from SNR on October 31, 2006.
- Upon Nuclea's acquisition of the instant patent on July 16, 2012, Attorney Evans discovered the maintenance fees for the 3.5 and 7.5 year maintenance fee had not been paid. Petitioner contends neither Mr. Rasmussen nor attorney Evans was aware of the lapse when the patent was assigned to Nuclea.
- The petition is accompanied by declarations of Mr. Rasmussen and Attorney Evans.
- Petitioner acknowledges the online transaction history indicates a Maintenance fee reminder was mailed to SNR on October 15, 2007.
- On petition, petitioner has provided the 3.5 and 7.5 year maintenance fees.

**APPLICATION OF THE UNAVOIDABLE STANDARD**

Petitioner's arguments have been considered but are not persuasive. In general a grantable petition under 37 CFR 1.378 (b) must show 1) petitioner knew of the need to make the

3) treated the payment of the maintenance fee (and later the filing of a petition to reinstate) as his most important business 4) was prevented from making the payment and 5) must show the entire delay in making the payment and submitting a grantable petition was unavoidable.

In essence, petitioner must show that he was aware of the need to pay the maintenance fee, and to that end was tracking it, or had engaged someone to track it before the expiration, but when the fee came due, was "unavoidably" prevented from making the maintenance fee payment due. In determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray, 55 F3d at 608-609, 34 USPQ2D at 1787. It is incumbent upon the patent owner to implement steps to schedule and pay the fee, or obligate another to do so. See California Medical Products v. Technol. Med. Prod., 921 F.Supp 1219, 1259 (D. Del. 1995). That is, 37 CFR 1.378(b)(3) requires a showing of the steps in place to pay the maintenance fee, and the record currently lacks a showing that any steps were emplaced by petitioner or anyone else. In the absence of a showing that petitioner or anyone else was engaged in tracking the maintenance fee due dates, and that party had in fact been tracking the due dates with a reliable tracking system, such as would be used by prudent and careful men in relation to their most important business, petitioner cannot reasonably show that the delay was unavoidable delay. In re Katrapat, 6 USPQ2d 1863, 1867-1868 (Comm'r Pat. 1988); California, supra.

When determining whether a delay in paying a maintenance fee is unavoidable, the Office looks at whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person.<sup>9</sup> Although the petition and the declaration of Attorney Evans state that DNR maintained a docketing system, no evidence about the docketing system and whether the instant patent was ever entered into the docketing system has been provided. Based on the lack of evidence provided regarding the docketing system purportedly used, the Office cannot make a determination as to whether any system which may have been used was reliable and that is was reasonable to rely on this system.

It is solely the responsibility of the patentee to ensure that the maintenance fee is paid timely to prevent expiration of the patent. Failure to monitor the status of a patent does not reflect the due care and diligence employed by a prudent and careful person with respect to their most important business and as such cannot demonstrate that the delay was unavoidable delay. The record lacks any showing that Laurus the assignee at the time the 3.5 year maintenance fee window was open, took any action to prevent the expiration of the patent. A petitioner who is treating his patent as his most important business would have attempted to contact DNR to ensure that appropriate action had been taken on Laurus' behalf. If it was determined DNR had not handled the application as petitioner desired, it is then petitioner's responsibility to either timely seek other counsel or submit the maintenance fee on petitioner's own behalf. Petitioner has failed to provide any evidence that it was DNR's duty to inform petitioner of the due date of the maintenance fee. The record lacks any showing that the attorney or any firm which was associated with this patent ever represented to Laurus that the maintenance fee had been paid, much less that petitioner ever paid DNR for services rendered with respect to the maintenance fee payment. Further there is no

<sup>9</sup> See Kim v. Quigg, 718 F. Supp 1280,1284 12 USPQ2d 1604, 1607(E.D. Va 1989).

indication that Laurus requested that the maintenance fee be paid and provided the fees to effectuate payment. What was the general procedure used to ensure the payment of the maintenance fee? Petitioner has failed to provide explanation as to why Laurus was prevented from making the maintenance fee let alone establish that the failure to pay the maintenance fee was unavoidable.

It is not clear that Mr. Rasmussen, as the agent of the Joint Official Liquidators would have been in a position to know whether Laurus intended to submit the 3.5 year maintenance fee. The window to pay the 3.5 of year maintenance fee opened April 6, 2007 and closed April 7, 2008(with surcharge). Laurus entered into liquidation in September 2008. Further, would Mr. Rasmussen be in a position to be familiar with whether Laurus ever received either the maintenance fee reminder which was mailed on October 15, 2007 or the Notice of Patent Expiration mailed on May 5, 2008.

The Office looks to the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant/patentee and their successors, and the applicant/patentee and their successors are bound by the consequences of those actions or inactions. *Link v. Wabash*, 370 U.S. 626, 633-34 (1962). In this instance, DNR was or should have been aware that the maintenance fee was due and had not been paid. Further, sufficient evidence (beyond the statement by Mr. Rasmussen it would go against the goal of providing the most value to the owners and creditors) that Laurus decided not to pay the maintenance fees or that the failure to pay was unavoidable has not been presented. As such Nuclea is bound by those actions and inactions of DNR and Laurus.

Ultimately, petitioner argues that the failure to submit the maintenance fee was due to the failure to communicate with DNR. It is well established that a failure to communicate between a client and an attorney is not unavoidable delay *In re Kim*, 12 USPQ2d 1595 (Comm'r Pat. 1988). A delay resulting from an attorney's preoccupation with other legal matters or with the attorney's inadvertence or mistake is not sufficient to establish to the satisfaction of the Director that the delay was unavoidable within the meaning of 35 USC 151 and 37 CFR 1.378 *Mossinghoff*, 671 F.2d at 536. Specifically, petitioner's delay caused by the mistakes or negligence of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 U.S.C. 133 or 37 CFR 1.137(a).

In the absence of a showing that any steps had been taken, then 37 CFR 1.378(b) precludes acceptance of the payment. In other words, if no steps were taken by Laurus to track the fee payment, then the subsequent delay is immaterial. The showing must be that when the system indicated the fee fell due, petitioner was "unavoidably" prevented from taking any earlier action with respect to this patent.

Accordingly, the facts presented do not allow for a finding of unavoidable delay.

When filing documentation in support of applications or petitions, please take steps to protect all personal information. "Personal information" includes social security, credit card and banking account numbers. This type of personal data is never required by the USPTO to support a petition

or application. To protect your privacy, we suggest that you delete such information from any documentation you send the office.

### **Petitioner's current options**

#### **I. Petitioner may file a request for reconsideration.**

Any request for reconsideration of this decision must be filed within **TWO MONTHS** of the mailing date of this decision. Any such petition for reconsideration must be accompanied by the \$400 petition fee set forth in §1.17(h). After decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director. Accordingly, on request for reconsideration, it is extremely important the petitioner supply **any** and **all** relevant information and documentation in order to meet his burden of showing unavoidable delay. This includes statements by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. If a request for reconsideration is filed, it must establish that the entire delay in the submission of the maintenance fee was unavoidable.

#### **II. Petitioner may request a refund of the maintenance fee and surcharge which accompanied the petition.**

Petitioner may request a refund of the maintenance fee and surcharge by writing to the Office of Finance, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313. A copy of this decision should accompany petitioner's request.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record. A clear request to change the correspondence address must be submitted.

Further correspondence with respect to this matter should be addressed as follows:

By Mail:                      Mail Stop PETITION  
                                    Commissioner for Patents  
                                    Post Office Box 1450  
                                    Alexandria, VA 22313-1450

By Hand:                     U. S. Patent and Trademark Office  
                                    Customer Service Window, Mail Stop Petitions  
                                    Randolph Building  
                                    401 Dulany Street  
                                    Alexandria, VA 22314

The centralized facsimile number is (571) 273-8300.

Correspondence regarding this decision may also be filed through the electronic filing system of the USPTO.

Telephone inquiries should be directed to the undersigned at (571) 272-3215.

/Charlema Grant/  
Charlema Grant  
Attorney Advisor  
Office of Petitions

Cc: Paula C. Evans  
46 Elm Street  
Pittsfield, MA